

REMARKS

Claims 1-25 are in the case and presented for consideration.

Claims 16-20 were rejected under 35 U.S.C. 101 as directed to non-statutory subject matter, *specifically a signal*. Applicants are not clear as to why claim 16 has been rejected since claim 16 was previously amended to recite a computer-readable medium. It is well-established that a computer readable medium is statutory subject matter. *see* In re Warmerdam, 33 F.3d 1354 (Fed. Cir. 1994), In re Lowry, 32 F.3d 1579 (Fed. Cir. 1994), In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995). However, it is noted that claims 17-20 were not amended accordingly in the previous response, and still recited a signal. Claims 17-20 are amended herein to recite a computer-readable medium. Claims 16-20 are believed to be statutory and in compliance with 35 U.S.C. 101.

Applicants withdraw and retract all previous amendments and arguments. Accordingly, all prior amendments are not believed to affect the scope of the claims and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents.

The independent claims have been amended to recite “associated with...” for antecedent basis for “associated item,” which is later recited in the claims.

Claims 1, 3-6, 8-11, 13-16, and 18-20 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. 6,637,029 to Maissel.

Applicants respectfully submit that the Office has not established a *prima facie* case of anticipation with respect to the rejected claims.

The Board of Patent Appeals and Interferences has held that: "To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out *where* all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoyo Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Applicants respectfully remind the Examiner that it is the duty of the Examiner to specifically identify each and every element and limitation of a claim in the cited reference as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

Turning to the instant rejection, the Office does not clearly explain the pertinence of the cited reference and does not identify where all of the specific elements and limitations are found in the cited reference relied upon, as required by statute and *Ex Parte Naoyo Isoda*. Instead, the Office simply *repeats the claims* (both independent and dependent) verbatim in one long run-on sentence, without any analysis or explanation as to which features of the cited reference are deemed to correspond to the claimed elements. Although the Office adds references to the Abstract, Fig. 9D, and various columns and lines *at the end* of the entire paragraph, it is entirely unclear as to which columns and lines address which claims, and *specifically* which features of the cited reference correspond to which claim elements and limitations. For example, it is not clear which feature of the cited

reference is deemed to be construed as the claimed “graphical element” and which feature is deemed to be construed as the claimed “graphical feature”. (Since this is only an example, it should not be construed as the only analysis required from the Office.) Referring vaguely to drawings and columns and lines without any explanation does not satisfy 37 C.F.R. §1.104(c)(2).

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. (See MPEP §706). Repeating the claims verbatim with vague references to drawings and columns and lines without any explanation does not satisfy the goal of examination. Applicants filed an RCE *solely* because the Examiner’s rejection has not been clearly articulated thus far, and herein request that the Office provide a clear claim construction and analysis of the cited reference.

Thus, in response to the filing of this amendment with RCE, the Office is expected to provide a detailed analysis explaining specifically where each element and limitation of the claims is found in the cited reference (e.g., by identifying specifically which features in the cited reference correspond to the claimed elements and limitations and identifying the location in the cited reference of such features).

Furthermore, MPEP 2131 states:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*,

868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Board of Patent Appeals and Interferences has consistently upheld this premise: "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Although the relevance of the cited reference has not been explained clearly by the Office, Applicants respectfully believe that the cited reference does not teach or suggest at least one element or limitation of the claims. In particular, claim 1 recites "a display controller generating a plurality of graphical elements...wherein the graphical element is updated in response to any change to the specified criteria or the search pool." Maissel does not teach or suggest this limitation.

In Maissel '029, a receiving unit 120 is operative to receive program schedule information and to pass the program schedule information to the intelligent agent 130 (*see* col. 11, lines 47-51). The intelligent agent 130 is operative to store program characteristics in a viewer preference profile (*see* col. 12, lines 23-30). The intelligent agent 130 is also operative to customize the program schedule information received from the receiving unit 120 in accordance with one or more viewer preference profiles (*see* col. 13, lines 34-37). A program guide comprising the customized schedule information is output to a display apparatus 150 for display (*see* col. 13, lines 37-40). Fig. 2 and the specification clearly

describe the display of the customized schedule as occurring *after* the customization of the program schedule information. There is absolutely no disclosure or teaching in Maissel '029 that any updating of the schedule information occurs *after* the customized schedule is displayed.

Claim 1 first recites “a display controller generating a plurality of graphical elements...” Claim 1 further recites “wherein the graphical element is updated in response to any change to the specified criteria or the search pool”. Thus, claim 1 requires that graphical elements generated by a display controller be updated in response to any change to the specified criteria or the search pool. Based on Applicant’s understanding of the Office’s rejection, Maissel '029 discloses a display apparatus 150 which displays customized program schedule information. Maissel '029 does not teach or suggest that customized program schedule information (or anything generated by a display controller) is updated in response to any change to specified criteria or search pool. In fact, Maissel '029 never discloses or suggests that any update occurs *after* the customized program schedule information is displayed by display apparatus 150. Nor does Maissel '029 disclose that any change to specified criteria or a search pool occurs *after* the customized program schedule information is displayed.

The Office makes reference to Fig. 9D. Fig. 9D does not teach or suggest any update to any graphical element in response to any change to the specified criteria or the search pool. Rather, the icons are only selectable. Maissel '029 indicates that:

In FIG. 9D, the icons 390 on the screen display represent program subject matter such as, for example, comedy programs

or, as indicated by a news icon 395, news programs and, as indicated by a drama icon 397, drama programs. The viewer may preferably select, using methods well known in the art such as *by moving a cursor and selecting with a mouse* (not shown) or other input device well-known in the art, any of the icons 390 of FIG. 9D in order to obtain more detailed information on programs falling under the selected subject matter. (Emphasis added)

The Office also makes reference to col. 12, line 46 et seq., which discloses that the viewer can edit a viewer profile. Applicants do not understand the relevance of this citation. This is another example of the rejection not being articulated early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

Furthermore, claims 6, 9-11, 14-16, 19-20, and 24 recite that the graphical element is *automatically* updated. Maissel '029 does not teach or suggest this limitation. In the Final Office Action dated October 18, 2006, the Office responded in the *Response to Arguments* section that "it can be realized that, e.g., when Maissel's graphical element is updated, it is updated dynamically because an update could imply or mark a change, and any change is interpretable to be dynamic." Even assuming *arguendo* that the Office's interpretation is correct (which Applicants do not concede), not every update or change is interpretable to be automatic. Although it has been explained above that a graphic element is not updated in Maissel '029, it further clear that a graphic element is not automatically updated either in Maissel '029.

Claim 22 recites that "the graphical feature is automatically updated without user intervention in response to any change to the specified criteria or the search pool".

Applicants respectfully submit that this limitation is not taught or suggested by Maissel '029 either.

Claims 23 and 25 also recite at least one element or limitation not taught or suggested by the cited reference.

Claims 2, 7, 12, and 17 were rejected under 35 U.S.C. 103(a) as being obvious from U.S. Patent 6,637,029 to Maissel in view of U.S. Patent 6,243,093 to Czerwinski.

Since the rejected claims depend from independent claims which are believed to be patentable over Maissel '029 alone, these rejected claims are believed to be patentable for at least the same reasons.

Furthermore, Applicants respectfully submit that the Office has not articulated its rejection in a manner understandable by Applicants. Again, the Office simply restates the rejected claims verbatim, without any reasonable explanation. The Office's rejection does not satisfy the goal of examination to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. Nor does the rejection satisfy the holding in *Ex Parte Naoyo Isoda* or 37 C.F.R. §1.104(c)(2), which requires that the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The Office's reasoning also appears to be entirely conclusory. The courts have consistently upheld that the claimed combination must be suggested by the prior art, rather than by the applicants' specification:

"When prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must *suggest* the desirability, and thus the obviousness, of making the combination. It is impermissible to use the claims as a frame and the prior-art references as a mosaic to piece together a facsimile of the claimed invention." (emphasis added) *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art *suggested* the desirability of the modification." (emphasis added) *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Thus, the Office's allegation of a motivation to combine the references without any articulation of a suggestion in the references to combine the references is insufficient. Nor has the Office articulated any reasonable *prima facie* showing of obviousness by vaguely referring to graphical elements in the references without even identifying what features in the references are deemed to be graphical elements.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

The Commissioner is hereby authorized to credit any overpayment or charge any fee (except the issue fee) to Account No. 14-1270.

Respectfully submitted,

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